

REMARKS

Claims 1-27 are pending. Claims 1, 8, 17, 22 and 27 have been amended.

Applicant wants to thank the Examiner for kindly taking the time to discuss the application.

Rejections under 35 U.S.C. § 103

Claims 1-27 stand rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,073,021 to Kumar (“Kumar”) in view of U.S. Patent No. 5,805,648 to Sutton (“Sutton”) and U.S. Patent No. 6,301,311 B1 to Sheba (“Sheba”).

As the PTO recognizes in MPEP § 2143, “[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added). Furthermore, under MPEP § 2142, “[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” Applicant respectfully submits that the combination of Kumar, Sheba and Sutton fails to teach or suggest each element of claims 1-27, as required by MPEP § 2143.

Independent claims

1. Combination of references fails to teach or suggest all claim elements

Independent claim 1

Claim 1 recites: “A method for performing a handoff in a wireless communication system between a primary base station transceiver and a first one of at least two neighboring base station transceivers, the method comprising:

receiving a communications signal from a mobile unit, wherein the communications signal includes a phase offset from a pilot signal from the first neighboring base station transceiver,

beginning a handoff process,

detecting if an ambiguity exists wherein the ambiguity consists essentially of the condition under which the phase offset is in a neighbor search window for both neighboring base station transceivers,

if the ambiguity exists, resolving the ambiguity by associating the phase offset with the first neighboring base station transceiver, and

completing the handoff process to the first neighboring base station transceiver.”
(emphasis added)

However, the cited text of Kumar, Sutton and Sheba fails to teach or suggest the above claimed elements. Further, the amended claim 1 defines the term “ambiguity” as consisting essentially of the condition under which the phase offset is in a neighbor search window for both neighboring base station transceivers. In contrast, the rejection of claim 1 is based on the interpretation that the term “ambiguity” means any discriminator between base stations.

Accordingly, the cited combination of references fails to meet the standard embodied in MPEP § 2143, and claim 1 is allowable over the cited references.

Independent claims 8, 17, 22 and 27

Each of claims 8, 17, 22 and 27 includes elements similar to those of claim 1, and should also be allowed for at least the same reasons discussed above with respect to claim 1. It is noted that other elements of claims 8, 17, 22 and 27 have not been addressed herein, as only one element that is not taught or suggested by cited references is necessary for overcoming the rejections.

2. Combination of references is improper

Furthermore, Applicant respectfully submits that the combination of Kumar, Sheba and Sutton is improper. § 2142 of the MPEP also provides: “...the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole’.”

Here, none of Kumar, Sheba and Sutton teaches, or even suggests, the desirability of the combination since neither teaches the specific arrangement of as specified in claims 1, 8, 17, 22 and 27.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection with respect to claims 1, 8, 17, 22 and 27. Accordingly, claims 1, 8, 17, 22 and 27 are allowable.

Dependent claims

Dependent claims 2-7, 9-16, 18-21, and 23-26 depend from and further limit claims 1, 8, 17, and 22, and should also be allowed.

Conclusion

It is respectfully submitted that all the claims in the application are in condition for allowance. Should the Examiner deem that any further amendment is needed to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

T. F. Bliss

Timothy F. Bliss
Registration No. 50,925

Dated: June 23, 2004
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972 739-8638
Facsimile: 214 200-0853
File: 22171.232

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 23, 2004.

Gayle Conner
Gayle Conner